

REMARKS

This paper is submitted in response to the non-final office action dated August 18, 2005. In the office action, the species election restriction requirement made in the previous office action was withdrawn. The office action contained an objection to the drawings under 37 C.F.R. § 183(a) as not showing every feature of the invention specified in the claims. The office action also contained an objection to claim 6 because of a typographical error. In the office action the disclosure was objected to under 37 C.F.R. § 1.71 as containing no description of injection molded styrene.

In addition, claim 9 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claim 1 was rejected as anticipated by Howlett, U.S. Patent No. 1,984,216, and claims 1, 10-12, and 14 were rejected under 35 U.S.C. § 103(a) as being obvious over Howlett in view of Feer et al., U.S. Patent No. 5,312,054, Heard, U.S. Patent No. 2,482,180, and Elder, U.S. Patent 6,428,407. Claims 2, 3, 8, 13, 15, and 16 were rejected as obvious over Howlett in view of Feer et al., Heard, Elder, and Kaposi et al., U.S. Patent No. 6,135,375. Claims 7, 9, and 18 were rejected as obvious over Howlett in view of Feer et al., Heard, Elder, and Himminghofen et al., U.S. Patent No. 6,082,645. Claims 4, 17, 19, and 20 were rejected as obvious over Howlett in view of Feer et al., Heard, Elder, Kaposi et al., Himminghofen, and Brousseau et al., U.S. Design Patent No. D491,774.

Objection to the Drawings

Applicants respectfully traverse the objection to the drawings in view of the amendments to the drawings submitted herewith, in which FIG. 6D has been added to the drawings, and corresponding text has been added to the application to depict and describe the first and third panels being foldable over the second panel so that the one or more outwardly protruding grating elements of the second panel are covered by either the first or third panels

and the one or more outwardly protruding grating elements of the first and the third panels are facing toward the second panel when the first and third panels are folded over the second panel. No new matter has been added to the application by these amendments to the drawings and text. Support for these amendments to the drawings and text is included in the application as originally filed, for example, at page 6, line 31 through page 7, line 2. A new drawing sheet containing additional FIG. 6D is submitted herewith.

Claim Objections

Applicants respectfully traverse the objection to claim 6, as the claim has been amended to correct the typographical error that was kindly noted by the examiner.

Objection to the Specification

Applicants respectfully traverse the objection to the specification, as the specification has been amended to include a description of injected molded styrene. No new matter has been added by this amendment, as support for the amendment is contained in claim 9 as originally filed.

Claim Rejections Under 35 U.S.C. § 112

Applicants respectfully traverse the rejection of claim 9 as failing to comply with the written description requirement, since the subject matter of this claim has been incorporated into the description in the specification.

Claim Rejections Under 35 U.S.C. § 102

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, a determination that a claim is anticipated under 35 USC § 102 involves two analytical steps. First, the U.S. Patent and Trademark Office (PTO) must interpret the claim language, where necessary, to ascertain its meaning and scope. In interpreting the claim

language, the PTO is permitted to attribute to the claims only their broadest *reasonable* meaning as understood by persons having ordinary skill in the art, considered in view of the entire disclosure of the specification. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Second, the PTO must compare the construed claim to a single prior art reference and set forth factual findings that “each and every limitation is found either expressly or inherently [disclosed] in [that] single prior art reference.” *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1360, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998). Additionally, “[t]he identical invention must be shown in as complete detail as is contained in the patent claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants respectfully traverse the rejection of claim 1 as anticipated by Howlett. Contrary to the assertion in the office action, Howlett does not disclose or suggest a food grater with three grating panels or three panels for grating. Instead, Howlett is directed to a food grater having a single grating panel (“plate 12”). In addition, what the office action has characterized as a “third end panel (15)” is actually a “hinged bale 15” and not at all similar to a panel. Furthermore, the office action asserts that “the first and third end panels” of Howlett “comprise a latch mechanism for detachably connection [sic]” while there is in reality no such disclosure of a latch mechanism in Howlett. Instead, Howlett states that “the bale is of dimensions enabling its free end to engage the flanged end of the plate 12 and support the latter in an angle or upright position as illustrated in Fig. 1.” Howlett at page 1, right-hand column, lines 2-6.

Accordingly, the rejection of claim 1 as anticipated by Howlett is improper and should be withdrawn, since Howlett does not disclose or suggest all of the elements recited in claim 1.

Claim Rejections Under 35 U.S.C. § 103

The PTO “has the burden under § 103 to establish a prima facie case of obviousness.” *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). To establish a prima facie case of obviousness, the PTO must satisfy three basic criteria. First, the PTO must show that the combined disclosure of the prior art references teaches or suggests all of the claim limitations. *See* MPEP § 2143 (8th ed., May 2004). Moreover, it is “incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.” *Ex parte Levy*, 17 USPQ2d 1461, 1462 (Bd. Pat. App. & Inter. 1990).

Second, where obviousness is alleged to arise from a combination of elements across a plurality of references, the PTO must show the existence of some suggestion, motivation, or teaching to those skilled in the art to make the precise combination recited in the claims. *See Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1320 (Fed. Cir. 2004).

Compliance with this requirement prevents the PTO’s use of “the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability— the essence of hindsight.”

Ecolochem, Inc. v. Southern Cal. Edison Co., 227 F.3d 1361, 1371-72 (Fed. Cir. 2000) (quoting *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)). Evidence of a suggestion or motivation to combine prior art references may come from “the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved.” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000). The PTO’s showing “must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not ‘evidence.’” *Id.* (quoting *In re Dembiczak*, 175 F.3d at 1000).

Indeed, the U.S. Court of Appeals for the Federal Circuit has consistently held that a person having ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but also some motivation to combine the prior art teachings in the particular manner claimed. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“Particular

findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”).

To support a conclusion that a claimed combination is *prima facie* obvious, either (a) the references must expressly or impliedly suggest the claimed combination to one of ordinary skill in the art, or (b) the PTO must present a convincing line of reasoning as to why a person of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *See Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985); *see also, In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the PTO is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). The PTO must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. *Id.*; *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”).

Finally, the PTO must demonstrate that a person having ordinary skill in the art would have a reasonable expectation of success when combining the disclosures of the references. The suggestion or motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and must not be derived by hindsight from knowledge of the application’s disclosure. *In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988); MPEP § 2143.

Applicants respectfully traverse the rejection of claims 1, 10-12, and 14 as obvious over Howlett in view of Feer et al., Heard, and Elder. As noted above, Howlett does not disclose or suggest the use of more than one grating panel. None of Feer et al., Heard, or

Elder, alone or in combination make up for the deficiencies of Howlett, with regard to the food grater of claims 1, 10-12, and 14. In addition, none of the aforementioned references disclose or suggest a latch mechanism for detachably connecting a first panel to a third panel.

In addition, Elder is not directed to a grater, but is instead directed to a “multigrit manual finishing tool and method for making the tool.” Accordingly, Elder is directed to non-analogous art, and one skilled in the art would not look to the teachings of Elder in order to arrive at the claimed invention. Furthermore, the office action states that “Elder discloses hinged three panels with protruding sharp elements (50)” but Elder actually discloses coated abrasive pieces 10 that each include a grit surface 50. Thus, it is incorrect to characterize the grit surface 50 as including “protruding sharp elements” and one skilled in the art seeking to solve the problem of avoiding exposed sharp elements when a grater is in a folded configuration would not look to the teachings of Elder et al.

With regard to the rejection of claims 2, 3, 8, 13, 15, and 16 as obvious over Howlett in view of Feer et al, Heard, Elder, and Kaposi et al., applicants respectfully traverse this rejection for the same reasons set forth above with regard to claims 1, 10-12, and 14.

CONCLUSION

For the reasons stated above, the Applicant submits that the specification and claims are in proper form and clearly define patentable subject matter over the prior art. Therefore, prompt reconsideration and allowance of the application is respectfully requested.

No additional fee is believed due at this time. However, the Commissioner is hereby authorized to charge any fee deficiency, or to credit any overpayments, to Deposit Account No. 13-2855 of the undersigned's firm.

Respectfully submitted,

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AMENDMENTS TO THE DRAWINGS:

Please add to the drawings the New Sheet submitted herewith, that contains new Fig.
6D.